

"Express Mail" mailing label number EL920879897US #2

Date of Deposit: December 11, 2001

Our Case No. 9623/378

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Paine, Mark, et al. )  
Serial No. *not yet assigned* ) Examiner *not yet assigned*  
Filing Date: December 11, 2001 ) Group Art Unit No.: *not yet assigned*  
For RECOMMENDING SEARCH )  
TERMS USING COLLABORATIVE )  
FILTERING AND WEB SPIDERING )

**PETITION UNDER 37 C.F.R. 1.183**

Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Applicants respectfully request waiver of the requirement under 37 C.F.R. § 1.52(e) for including in the transmittal letter and specification of the patent application filed herewith a list of the names of the files contained on the compact disk, with other identifying information. The number of files on the enclosed disk is too great to practically include such a list.

Background

For filing electronic documents that are to become part of permanent records of the U.S. Patent and Trademark Office, 37 C.F.R. § 1.52(e) provides that such documents may be submitted on a compact disc read only memory (CD-ROM) or compact disk-recordable (CD-R). Rules are provided for format and content of the submission.

Among the information to be provided is a list of the files contained on the submitted compact discs. This information must be provided in two places when submitting a compact disk as part of a patent application. "The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph..., identifying each

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compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes.” 37 C.F.R. § 1.52(e)(5) (2001). Further, “[t]he transmittal letter must list for each compact disc … a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation....” 37 C.F.R. § 1.52(e)(3)(ii) (2001).

Accordingly, the currently-established rules for submitting documents in electronic form on CD-ROM or CD-R require listing of the names of all files in both the patent application and transmittal letter.

#### The Present Application

The present application is related to U.S. patent application number 09/911,674 filed July 24, 2001 in the names of Darren J. Davis, et al., entitled SYSTEM AND METHOD FOR INFLUENCING A POSITION ON A SEARCH RESULT LIST GENERATED BY A COMPUTER NETWORK SEARCH ENGINE, which in turn is a continuation application claiming priority of grandparent application serial number 09/322,677 (“the ‘677 application”), issued as U.S. patent number 6,269,361 on July 31, 2001. The ‘677 application was filed on May 29, 1999. The ‘677 application included a source code appendix filed in microfiche format and consisting of sixty three sheets of microfiche filed with the application in accordance with US Patent and Trademark Office practice at the time. The specification of the ‘677 application included an incorporation by reference of the microfiche appendix.

A source code appendix is also included with the present application. In accordance with 37 C.F.R. § 1.52(e), the source code appendix has been stored on two identical CD-R compact discs in IBM-PC format under the MS-Windows operating system. On the compact discs filed with the application, at the top directory level of each disc is a file named “dir\_s” which identifies each file on the compact disc by the names of the files, their date of creation and their sizes in bytes. Also at the top directory level of each disc is a folder named “Goto” which contains seventeen sub-folders including the files identified in the file dir\_s. Also at the top directory level is a folder named “EightBall” which contains subfolders “Data,” “Goto” and “Rawinput,” and files “Phrasemap,” “Stoplist,” “Terms” and “Wordmap.”

The total number of files contained on the CD-R compact disc is 37,913. The total number of bytes contained on the CD-R compact disc is 539,489,774.

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The total number of files is so large that the required identifying information can not be reasonably included in the incorporation by reference in the specification of the present application or in the transmittal letter for the present application. When displayed, the file dir\_s which identifies each file on the compact disc is more than 1,000 pages long. Including such a large file in hard-copy form in the patent specification and transmittal letter would produce a patent file which is inconvenient to handle and process within the U.S. Patent and Trademark Office. Expenses for photocopying, data capture and other processing will be unduly increased both for the application and any continuation or divisional applications, and for any patents which may be granted on such applications.

Accordingly, it is proposed to include in the incorporation by reference of the specification of the present application a reference to the file dir\_s on the compact disc which identifies each file on the compact disc. The present patent application has been filed with the following incorporation by reference:

A compact disc appendix is included containing computer program code listings pursuant to 37 C.F.R. 1.52(e) and is hereby incorporated by reference in its entirety. The total number of compact discs is 1 including 37,913 files and 435,383,970 bytes. The files included on the compact disc are listed in a file on the compact disc entitled "dir\_s". Because of the large number of files contained on the compact disc, the required listing of file names, dates of creation and sizes in bytes is included in the file on the compact disk and incorporated by reference herein.

It is further proposed to include in the transmittal letter a reference to the file dir\_s on the compact disc which identifies each file on the compact disc. The transmittal letter for the present application includes the following information:

Enclosed are: ... two identical compact discs marked COPY 1 and COPY 2 and having a CD-R appendix containing computer source code in IBM-PC format compatible with MS-Windows operating system; a list of the 37,913 files contained on the compact discs is provided in a file at the top directory level of each compact disc in a file called "dir\_s"

Accordingly, because of the extraordinary situation created by the large number of files – 37,913 files -- contained on the compact discs filed with the present application, Applicants respectfully request waiver of the requirement under 37 C.F.R. § 1.52(e) for inclusion in the

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specification and transmittal letter of a list of files contained on each compact disc. Applicants further request approval of the above-quoted incorporation by reference and listing of the transmittal filed with the present application in fulfillment of the requirements of 37 C.F.R. § 1.52(e).

Fee payment

A check in the amount of \$130.00 is enclosed for the Petition fee under 37 C.F.R. § 1.17(h). Any additional fee required may be charged or credit for any excess fee may be paid to Deposit Account No. 23-1925. A duplicate of this document is attached.

Respectfully submitted,



John G. Rauch  
Registration No. 37,218  
Attorney for Applicant

December 11, 2001

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

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